

REMARKS

Receipt of the Office Action of September 15, 2009 is gratefully acknowledged.

The noted Office Action reopens prosecution of this application, removing it from appeal. The examiner indicates that this Office Action has been issued as "...responsive to the Appeal Brief....."

Claims 16 - 30 are pending, and these have been rejected by the examiner in the noted Office Action as follows: claims 16 - 30 under 35 USC 112, second paragraph as indefinite; claims 16 - 30 under 35 USC 101 as "directed to a non-statutory subject matter," and claims 16 - 30 under 35 USC 102(e) by Choe. The rejection under 35 USC 101 is new to the history of this prosecution.

35 USC 112, second paragraph

In this rejection, the examiner suggests certain changes to claim 16 which, presumably, would overcome this rejection. Accordingly, claim 16 has been amended as suggested by the examiner. Then, claims 17, 18, 21, 24, 28 and 30 have also been amended to render them consistent with the amendment to claim 16. As such, claims 16 - 30 are now believed to be in full compliance with the provisions of 35 USC 112, second paragraph.

35 USC 101

In this rejection, the examiner states that: "[c]laims 16 - 30 are rejected under 35 USC 101 because the claimed invention is neither tied to a machine or apparatus, nor does it perform a transformation." This language appears to be taken from the *In re Bilski* case 88 USPQ2d 1385 (Fed. Cir. 2008). This case has been taken by the U.S. Supreme Court, and oral arguments were heard on November 9, 2009. A decision has not as yet been issued by the Supreme Court, accordingly we look to the Federal Circuit decision.

It must first be noted that *Bilski* involved business method claims. Not so here. The majority in the *Bilski* case reviewed the wording of 35 USC 101 and then noted “[t]he true issue before us then is whether Applicants are seeking to claim a fundamental principle (such as an abstract idea)n or a mental process.” The court then reviewed its precedents and held that the business method claims merely performed “[p]urported transformations or manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances.” Here, we have no legal obligations or relationships, or the like. Here we have structure. There is a structural relationship which should not be ignored. The present claims relate to a method for monitoring the functioning of sensors, which is **not** an abstraction, and to reiterate “catch” phrases from cases that are in reality different does not make it so.

This rejection should be withdrawn.

35 USC 102(e)

This rejection was discussed in the Appeal Brief filed by Applicant. Regarding one of Applicant/Appellant’s arguments, the examiner states: “Applicant’s arguments are not well taken, as the ‘evaluating a backward-looking chronological development of the stored test parameters’ simply means that historical data is gathered and then evaluated to determine the functionality of the sensor.” And where did this “simple meaning” come from if not from Applicant. Then regarding another one of Applicant/Appellant’s arguments, the examiner again states that “...Applicant’s arguments are not well taken....[since] Choe teaches predicting from said evaluations the development of sensor behavior to be expected in the future” citing certain portions of the Choe specification. But how are these portions of the Choe specification linked with the evaluation performed by the backward-looking chronological development? That is necessary according to claim 16. This linkage is not apparent and the examiner

has not told how the linkage occurs.

It has already been stated that for Choe to anticipate claims 16 - 30, it must disclose each and every step claimed. It is not enough to find a step "here and there" and conclude that anticipation lies. It must teach the invention **as claimed**. It does not.

This rejection should also be withdrawn.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Felix J. D'Ambrosio", with a stylized flourish at the end.

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